



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/550,602

11/08/2005

Kiyoshi Midorikawa

330-305

4259

23117 7590 11/10/2008
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

TOUSSAINT, DALILA

ART UNIT

PAPER NUMBER

4152

MAIL DATE

DELIVERY MODE

11/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,602	Applicant(s) MIDORIKAWA ET AL.	
	Examiner DALILA TOUSSAINT	Art Unit 4152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/26/05, 11/8/05, 10/31/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1** and **3-5** are rejected under 35 U.S.C. 102(b) as being anticipated by **Hiroyoshi et al. JP publication 2000-201634 A** and further evidenced by **Ribeiro US publication 2004/0126437 A1**.

a. Referring to claim 1, Hiroyoshi et al. teaches:

(1) An active oxygen eliminator derived from a natural substance which comprises water, an organic solvent and an emulsifier (Detailed Discription (DD) page 1, ¶ 0007).

However, Hiroyoshi et al. is silent to the essential active components: p-coumarinic acid, 3,4-di-O-caffeoylquinic acid, 3,5-di-O-caffeoylquinic acid, 4-hydroxy-3-prenylcinnamic acid and 3,5,7-trihydroxy-4'-methoxyflavonol. These essential active components listed are natural occurring substances of Brazilian propolis, which is further evidenced by Ribeiro, which discloses the essential active components of Brazilian propolis (Ribeiro; Table XVIII). Hiroyoshi et al. disclose the use of Brazilian and other propolis in it production (Hiroyoshi et al.; abstract and DD page

Art Unit: 4152

1, ¶ 0010), thus establish a *prima facie* case of anticipation. Hiroyoshi et al. uses like materials in a like manner as claimed, it would therefore be expected that the natural active components listed in the instant claim will have the same characteristics.

b. Referring to claim 3, Hiroyoshi et al. and Ribeiro teaches:

(2) The active oxygen eliminator derived from a natural substance as claimed in claim 1, wherein the organic solvent is a polyhydric alcohol compound having 2 or more hydroxyl groups in a molecule (Hiroyoshi et al.; DD page 1, ¶ 0007).

c. Referring to claim 4, Hiroyoshi et al. and Ribeiro teaches:

(3) The active oxygen eliminator derived from a natural substance as claimed in claim 1, wherein the emulsifier is at least one member selected from a glycerin fatty acid ester, a polyglycerin fatty acid ester, a propylene glycol fatty acid ester, a sorbitan fatty acid ester, a sucrose fatty acid ester, lecitins and saponins (Hiroyoshi et al.; DD page 2, ¶ 0011).

d. Referring to claim 5, Hiroyoshi et al. and Ribeiro teaches:

(4) The food comprising the active oxygen eliminator derived from a natural substance recited in claim 1 (Hiroyoshi et al.; Abstract).

3. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by **Hiroyoshi et al. JP publication 2000-201634 A**, further evidenced by **Ribeiro US publication**

Art Unit: 4152

2004/0126437 A1, and further evidenced by Shigemi Tazawa, "Analysis of the constituents, chemical evaluation and tyrosinase inhibition of propolis" and Matsuhige K. "Potent free radical scavenging activity of dicaffeoyl quinic acid derivatives from propolis".

e. Referring to claim 2, Hiroyoshi et al. is silent to disclose:

(5) The active oxygen eliminator derived from a natural substance as claimed in claim 1, which further comprises, as active components, 3,5-diprenyl-4-hydroxycinnamic acid, keampheride, beturetol, chlorogenic acid, ermanin, caffeic acid, chrysin and vanillin.

Hiroyoshi et al. is silent to the natural active components listed above in the instant claim. However, Hiroyoshi et al discloses the use of Brazilian and other propolis in it production (Hiroyoshi et al.; abstract and DD page 1, ¶ 0010). Ribeiro discloses many of the essential active components naturally stemming from Brazilian propolis (Ribeiro; Table XVIII) except for chlorogenic acid and chrysin.

However, the article by Matsuhige disclose that chlorogenic acid is a free radical structure found in propolis from another region (Matsuhige K.; abstract) and the article by Tazawa disclose that chrysin is found in propolis (Tazawa; abstract), thus establishing a *prima facie* case of anticipation. Hiroyoshi et al. uses like materials in a like manner as

claimed, it would therefore be expected that the natural active components listed in the instant claim will have the same characteristics.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over by **Hiroyoshi et al. JP publication 2000-201634 A**, further in view of **Ribeiro US publication 2004/0126437 A1**.

f. Referring to claim 6, Hiroyoshi et al. fail to disclose:

(6) A cosmetic comprising an active oxygen eliminator derived from a natural substance recited in claim 1.

However, Ribeiro disclose the use of propolis in cosmetics (Ribeiro; page 4, ¶ 0028). At the time of invention it would have been obvious to

Art Unit: 4152

one skilled in the art, having teaching of Hiroyoshi et al. and Ribeiro before him or her, to modify Hiroyoshi et al. to include Brazilian propolis in cosmetics as Ribeiro discloses it uses. The motivation for doing so would have been to have propolis based products and some derivative compounds having therapeutical and biological activities (Ribeiro; page 4, ¶ 0028).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DALILA TOUSSAINT whose telephone number is (571)270-7088. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on (571)272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DT

/Joseph S. Del Sole/
Supervisory Patent Examiner, Art Unit 4152